

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/541,087	MENCKE ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	DANIELLE SULLIVAN	1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 April 2011.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-3 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

<b>Attachment(s)</b>	
1) <input type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ . 5) <input type="checkbox"/> Notice of Informal Patent Application 6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

Claim 1 was amended in the amendment filed 4/06/2011. Claim 4 was cancelled.

Claims 1-4 are pending examination.

### ***Withdrawn rejections***

Applicant's amendments and arguments filed 4/06/2011 are acknowledged and have been fully considered. In view of applicants amendment to claim 1 to remove the negative limitation of excluding lice capable of infecting humans the rejection under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is hereby withdrawn.

In view of applicants amendment to claim 1 the rejection under 102(b) for being anticipated by Snyder (US 6,063,771) as evidenced by Sembo et al. (US 6,201,017) has been withdrawn.

The following rejection was necessitated by Applicant's amendment.

### ***Maintained Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sembo et al. (US 6,201,017).

Applicant claims the method repelling ticks, fleas, midges and flies comprising applying an effective amount of a pyrethroid or pyrethrin in combination with a nicotinic agonist to a warm-blooded species.

Sembo et al. teach ectoparasite-controlling agents for animals comprising 0.1-20% by weight of the neonictinoid compounds and 10-95% of a glycol as a spot-on or pour-on treatment by dropping the agent onto the skin of the animal body (abstract; column 7, lines 10-13). The agent may comprise other actives selected from pyrethroid compounds, phenothrin (type I pyrethroid), cyfluthrin (type II pyrethroid) (column 6, lines 54-57). The pests controlled include cat flea, Diptera such as *Haematobia irritans* (horn fly), *Culicoides oxystoma* (midges) and Acarina (ticks) (column 7, lines 24-35).

Sembo et al. do not exemplify applying the neonictinoid in combination with pyrethroid compounds. However, it is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose, because the idea of combining them flows logically from their having been individually taught in prior art.” In re Kerkhoven 205 USPQ 1069, (C.C.P.A. 1980). Thus, combining a pyrethroid or pyrethrin with a nicotinic agonist (neonictinoid compounds) sets forth *prima facie* obvious subject matter. Additionally, the treatment of fleas, midges and flies would have also been *prima facie* obvious

It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the instant invention to utilize the teachings of Sembo et al. and combine a pyrethroid with a neonictinoid in a method of controlling ticks, fleas, midges and flies with a reasonable expectation of success. One would have been motivated to utilize a pyrethroid with a neonictinoid in a method of repelling ticks, fleas, midges and flies because Sembo et al. teaches applying the compounds as spot-on and pour-on formulations on the back of an animal in need thereof.

***Response to Arguments***

Applicant's arguments filed 4/06/2011 have been fully considered but they are not persuasive.

Applicant mainly argues that one looking at *controlling* ectoparasites would think to treat existing parasites and prevention of re-infestation, not repellency. Applicant argues treatment is therapeutic efficacy, whereas prevention is killing adult lice, developing stages and eggs before hatching. The Examiner is not convinced by this argument. Claims are given their broadest reasonable interpretation. Additionally an art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). The present claims are not limited to a specific time period in which the animals are treated to achieve repellency. The steps only require applying the compounds to an animal in need thereof. Therefore, whether the insects are controlled, repelled or killed is

an inherent property of following the method. Therefore, the claimed method of repelling is not different from the method of controlling taught by Sembo.

Applicant next argues that Sembo does not teach a pyrethroid or pyrethrin in combination with a nicotinic agonist act as repellents. Also, Applicant argues Sembo excludes pyrethroids as a repellent from the repellants list. The Examiner is not convinced by these arguments. First, the issue is whether the teachings of Sembo would have been obvious to use in a method of repelling insects. That is the case because the methods steps disclosed in the claims are the same as those disclosed in the prior art. Furthermore, just because pyrethroids are not specifically listed as “pest repelling compounds” does not imply that they do not have repellent activity. Furthermore, applicant must demonstrate unexpected results commensurate in scope with the claims in order to show that repellency is only achieved from the present invention, not the prior art.

***Response to Amendment***

The declaration under 37 CFR 1.132 filed 4/06/2011 is insufficient to overcome the rejection of claims 1-4 based upon the rejection under 35 U.S.C. 103(a) as being unpatentable over Sembo et al. (US 6,201,017) as set forth in the last Office action because: the declaration appears to be an opinion affidavit arguing that the term control/controlling fail to encompass repellency. Applicant fails to provide evidence that the teachings of Sembo teach away from the present invention and lacks a proper side-by-side analysis to show that repellency is not achieved by the teachings of Sembo. Therefore, the affidavit is not convincing.

***Conclusion***

No claims allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIELLE SULLIVAN whose telephone number is (571)270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fereydoun Sajjadi can be reached on (571) 272-3311. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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